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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: Constantine P. GRIGOROPOULOS, Nicole R. BIERI,
Dimos POULIKAKOS, Jaewon CHUNG

Atty. Doc. No.: UCB-6 (B01-108)

Serial No.: 10/621,046

Filed: July 16, 2003

Group Art Unit: 2813

Confirmation No.: 8907

Examiner:

Title: **A METHOD FOR PRODUCING A STRUCTURE USING
NANOPARTICLES**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

**Petition Pursuant to 35 U.S.C § 184 for
Retroactive Foreign Filing License**

Petition

Applicants respectfully petition pursuant to 35 U.S.C. § 184 that the foreign filing license granted for the above application on November 25, 2003 be given retroactive effect to January 9, 2001.

Basis for Granting Petition

35 U.S.C § 184 provides for the retroactive granting of a foreign filing license "where an application has been filed abroad through error and without deceptive

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intent and the application does not disclose an invention within the scope of section 181 of this title."

The facts and circumstances surrounding the filing of a European patent application on January 10, 2001 are described below, clearly demonstrating that the European filing without a foreign filing license was without deceptive intent. If the European filing lies outside the scope of 37 C.F.R. § 5.11 (e)(1), then the European filing without a foreign filing license was in error.

The subject matter of the European patent application clearly lies outside the scope of 35 U.S.C § 181 as shown by an analysis of the subject matter of the application and by the granting of a foreign filing license on November 23, 2003 including within its scope that subject matter.

Factual Background

During a sabbatical leave, Professor Constantine Grigoropoulos of the University of California, Berkeley, CA performed cooperative research with scientists at the ETH (Eidgenössische Technische Hochschule) of Zurich, Switzerland while he was in residence at ETH. This research resulted in a European Patent Application No. 01 100 537.8 filed January 10, 2001. A copy as filed in English is attached as Attachment A. A copy of the published application EP 1 223 615 A1 is also attached as Attachment B. Believing the invention was not made in the

United States, no foreign filing license was sought pursuant to 37 C.F.R. § 5.11(e)(1).

The above-referenced US patent application ("'046") was filed on July 16, 2003 for which a foreign filing license was granted on November 25, 2003, Attachment C. The '046 application includes subject matter from the European filing.

More thorough review of the facts and circumstances surrounding the invention tends to indicate the possibility that some features of the invention's conception may have occurred in the United States so as to invoke Sealectro Corp. vs. L.V.C. Industries (271 F. Supp. 835 (EDNY, 1967)). Applicants do not concede that Sealectro correctly states the applicable law, nor that the facts of the present invention and patent filings lie outside the provisions of 37 C.F.R. § 5.11(e)(1). However, applicants believe they fully comply with 35 U.S.C. § 184 and, therefore, hereby petition for retroactive effect to January 9, 2001 of the foreign filing license granted November 23, 2003.

Kindly charge the entire cost of \$ 130.00, as appropriate, of this petition to my deposit account

number 13-3083. To facilitate that charge, a duplicate copy of this petition is enclosed herewith.

Respectfully submitted,

July 29, 2004


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CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on **July 30, 2004** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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